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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/219,288 | 12/22/1998 | WILLIAM E. ASHER | BAE-037CP | 1977 |

7590 04/08/2003

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EXAMINER

ALEXANDER, LYLE

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1743

DATE MAILED: 04/08/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-22

Office Action Summary

Application No.

09/219,288

Applicant(s)

ASHER ET AL.

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25-43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kaish et al.

Kaish et al. teach a method and apparatus for the detection of tagged objects. In column 8 lines 40+ a system is taught that compares an IR spectra from a sample and compares it to a "library" of spectra to determine the identity of the sample. Figure 4 teaches measurement of the IR spectra from 4000-500 cm⁻¹ which has been read on the claimed IR spectra ranges. In column 3 lines 25+Kaish et al. states the infrared, visible and UV spectrum detection techniques are all used. In column 5 lines 22+ teach fluorescent and other detectors can be used.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish et al.

See Kaish et al. supra.

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Kaish et al. is silent to the claimed second detector, the specific measurement wavelengths as well and use of a microprocessor to superimpose the spectral signatures of the taggents.

The court decided St. Regis Paper Co. v. Bemis Co., Inc (193 USPQ 8,11) and In re Harza (124 USPQ 378) that the duplication of parts to achieve the expected result is has no patentable significance unless a new and unexpected result is achieved. It is desirable to have multiple detectors capable of being specific for certain regions of the spectra. This permits higher resolution for the specific region. Additionally sensors also provide redundancy in the system. It would have been within the skill of the art to modify Kaish et al. and duplicated the sensor to achieve the expected and well known result and to gain the above advantages.

The method use of the claimed apparatus (e.g. measurements at the claimed wavelengths) is of no patentable moment with respect to the pending apparatus claims provided the apparatus has the capability to perform the claimed method. The claimed apparatus has the capability to measure a range of wavelengths encompassing the claimed specific wavelengths and inherent is capable of measuring the claimed wavelengths. Additionally, the court decided In re Irmischer (66 USPQ 314) "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation". In the instant case, Kaish et al. teaches a broad range that encompasses the claimed specific values. It would have been within the skill of the art as experimental design choice to select specific wavelengths based upon the well known characteristics of the chosen indicator. This

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would have been accomplished routine experimentation. It would have been within the skill of the art to modify Kaish et al. and use the claimed wavelength ranges as discovery of the proper wavelength associated with the selected tag by routine experimentation.

The use of microprocessors is ubiquitous in the field of analytical chemistry as means to translate signals into data, organize, save, manipulate and display data. Microprocessors have the advantages of being relatively inexpensive, can be dedicated/embedded to use with a particular instrument and are small. It would have been within the skill of the art to modify Kaish et al. and use a microprocessor to accomplish the taught function to gain the above advantages.

Response to Arguments

Applicant's arguments with respect to claim 25-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Lyle A Alexander
Primary Examiner
Art Unit 1743

April 4, 2003